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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/960,452 Confirmation No. 6599
Applicant : Olivier Dovergne
Filed : September 20, 2001
TC/A.U. : 3732
Examiner : PEDRO PHILOGENE
Title : DEVICE FOR APPLYING A SUBSTANCE TO THE HAIR
Docket No. : 35485
Customer No.: 000116

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

APPEAL BRIEF

Dear Sir:

Applicant submits this Appeal Brief in connection with an Appeal of the above-identified application. Payment for this Appeal Brief is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313-1450 on the date indicated below.

Ronald M. Kachmarik
Name of Attorney


Signature of Attorney

08/02/2005
Date

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(i) Real Party in Interest

The real party in interest in the present appeal is L'Oreal, a French corporate entity and the assignee of the present application.

(ii) Related Appeals and Interferences

The Appellant, the Appellant's legal representative, and the Assignee are not aware of any appeals or interferences that will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii) Status of Claims

Claims 1-62 are currently pending in the subject patent application.

Claims 45, 48 and 49 are allowed.

Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim.

Claims 54, 57 and 58 are rejected under 35 U.S.C. §112, second paragraph, but contain allowable subject matter. Thus, these claims would be allowable if rewritten to correct a lack of antecedent basis and rewritten in independent form including all of the limitations of the base claim.

Claims 1-42, 50, 52, 53, 55, 56 and 59-62 are rejected under 35 U.S.C. §112, second paragraph, as needing to correct a lack of antecedent basis.

As alternatives, entry of the previous after final amendment (filed May 9, 2005), which addressed the rejection under 35 U.S.C. §112, second paragraph, concerning claims 1-42, 50 and 52-62, is respectfully requested, or the rejection under 35 U.S.C. §112, second paragraph, is appealed as being unnecessary. As such, the status of claims 1-42, 50 and 52-62 concerning 35 U.S.C. §112, second paragraph, may change.

Claims 1-15, 18, 19, 31, 32, 35-43, 51, 52 and 60-62 are rejected under 35 U.S.C. §103(a) in view of a proffered combination of (1) De Lafocade (U.S. Patent No. 6,000,405) in view of (2) Margharehi (U.S. Patent No. 5,937,866).

Claims 13, 14, 20-30, 43, 44 and 53 are rejected under 35 U.S.C. §103(a) in view of a proffered combination of (1) De Lafocade in view of (2) Margharehi in view of (3) Kajgana (U.S. Patent No. 6,062,230).

Claims 33 and 34 are rejected under 35 U.S.C. §103(a) in view of a proffered combination of (1) De Lafocade in view of (2) Margharehi in view of (3) Diaz (U.S. Patent No. 5,937,864).

Claims 46, 47, 50, 55, 56 and 59 are rejected under 35 U.S.C. §103(a) in view of a proffered combination of (1) De Lafocade in view of (2) Margharehi in view of (3) Morganroth (U.S. Patent No. 4,273,144).

The rejection of claims 1-15, 18-44, 46, 47, 50-53, 55, 56 and 59-62 under U.S.C. §103(a) in view of various combinations of references is appealed.

A copy of the appealed claims is provided under section Appendix (viii) and attached hereto.

(iv) Status of Amendments

One amendment was submitted (filed May 9, 2005) subsequent to the final Office action dated December 21, 2004. The amendment only contained amendment items that addressed an issue concerning an antecedent basis rejection under 35 U.S.C. §112, second paragraph. The amendment was not entered. The amendment should have been entered to reduce issues for appeal. As such, entry of the amendment is respectfully requested.

(v) Summary of Claimed Subject Matter

Independent claims 1, 43, 44, 46, 47, 50, 51, 61 and 62 are involved in the Appeal. To aid in the review, subheadings are provided within this Summary section.

Claim 1

Claim 1 recites a device 1 for applying a substance to the hair. The device has a receptacle 2 that has a longitudinal axis X and that is configured for containing the substance to be applied. The device 1 has an applicator portion 3 fixed on the receptacle 2 and that has at least one delivery orifice 50 enabling the substance to be delivered. The applicator portion 3 has teeth 41, 43 arranged around a closed oval curve, each tooth having a longitudinal axis. The gaps between the teeth 41, 43 being such that they allow hairs to pass between the teeth while enabling the substance to be retained within the curve. The longitudinal axis of the teeth 43 are substantially parallel to the longitudinal axis X of the receptacle 2.

Claim 43

Claim 43 recites a device1 for applying a substance to the hair. The device 1 has a receptacle 2 configured for containing the substance to be applied. The device has an applicator portion 3 fixed on the receptacle 2 and that has at least one delivery orifice 50 enabling the substance to be delivered. The applicator portion has teeth 41, 43 arranged around a closed curve. The applicator portion 3 is removable, and is configured for fixing on the receptacle 2 in a first position and in a second position different from the first (compare Figs. 8 and 9, and Figs. 10 and 11). The receptacle 2 and the applicator portion 3 are configured such that in the first position the at least one delivery orifice does not communicate with the substance contained in the receptacle, and in the second position the at least one delivery orifice communicates with the substance contained in the receptacle. See the application specification, page 11, lines 18-37.

Claim 44

Claim 44 recites a device 1 for applying a substance to the hair. The device 1 has a receptacle 2configured for containing the substance to be applied. The device has an applicator portion 3 fixed on the receptacle 2 and that has at least one

delivery orifice 50 enabling the substance to be delivered. The applicator portion 3 has teeth 41, 43 arranged around a closed curve. The receptacle 2 has a skirt and the applicator portion 3 has an internal sealing lip 14 configured for bearing against the skirt of the receptacle 3 when the applicator portion 3 is fixed thereon. The internal lip 14 defining an inside space that is permanently in communication with the outside via the at least one substance delivery orifice 50 and that is capable of being isolated from an inside of the receptacle 2.

Claim 46

Claim 46 recites a device 1 for applying a substance to the hair. The device 1 has a receptacle 2 configured for containing the substance to be applied. The device 1 has an applicator portion 3 fixed on the receptacle and that has at least one delivery orifice 50 enabling the substance to be delivered. The applicator portion 3 has teeth 41, 43 arranged around a closed curve. The receptacle 2 has a container 4 and an adapter portion 6 to enable the applicator portion 3 to be fixed on the receptacle 2. The applicator portion 3 is removable mounted on the adapter portion 6. The adapter portion 6 has a sealing skirt 12 defining a housing with at least one substance delivery duct opening 30 out into the bottom thereof.

Claim 47

Claim 47 recites a device 1 for applying a substance to the hair. The device 1 has a receptacle 2 configured for containing the substance to be applied. The device 1 has an applicator portion 3 fixed on the receptacle 2 and that has at least one delivery orifice 50 enabling the substance to be delivered. The applicator portion 3 has teeth 41, 43 arranged around a closed curve. The receptacle 2 has a container 4 and an adapter portion 6 to enable the applicator portion 3 to be fixed on the receptacle 2. The applicator portion 3 is removably mounted on the adapter portion 6. The adapter portion 6 has a part made separately from the container and fixed thereon. The adapter portion 6 has a covering skirt 10 configured for

extending around a neck of the container 4 and a receiver skirt 11 for receiving the applicator portion 3.

Claim 50

Claim 50 recites a device 1 for applying a substance to the hair. The device 1 has a receptacle 2 configured for containing the substance to be applied. The device 1 has an applicator portion 3 fixed on the receptacle 2 and that has at least one delivery orifice 50 enabling the substance to be delivered. The applicator portion 3 has teeth 41, 43 arranged around a closed curve. The receptacle 2 has a container 4 and an adapter portion 6 to enable the applicator portion 3 to be fixed on the receptacle 2. The applicator portion 3 is removably mounted on the adapter portion 6. The applicator portion 3 has an assembly skirt 17. The adapter portion 3 is configured to enable the user to deform the assembly skirt 17 by pressing in opposite directions on bearing surfaces so as to modify the engagement between the receptacle 2 and the applicator portion 3, for the purpose of removing it.

Claim 51

Claim 51 recites a device 1' for applying a substance to the hair. The device 1' has a receptacle 4' configured for containing the substance to be applied. The device 1' has an applicator portion 3' fixed on the receptacle and that has at least one delivery orifice enabling the substance to be delivered. The applicator portion 3' has teeth 41, 43 arranged around a closed curve. The receptacle has a plurality of substance delivery ducts 82 and the applicator portion 3' has a plurality of shutters 84 suitable for engaging in the ducts to shut them when the applicator portion is in a first position, and suitable for taking up positions outside the ducts when the applicator portion is in a second position.

Claim 61

Claim 61 recites a device 1 for applying a substance to the hair. The device 1 has a receptacle 2 configured for containing the substance to be applied. The device 1 has an applicator portion 3 fixed on the receptacle 2 and that has at least one delivery orifice 50 enabling the substance to be delivered. The applicator portion 3 has teeth 41, 43 arranged around a closed curve, the gaps between the teeth being such that they allow hairs to pass between the teeth while enabling the substance to be retained within the curve. The applicator portion 3 has two outer rows 41 and at least one intermediate row 42 situated between the outer rows. The outer rows 41 meeting each other around the at least one intermediate row 42.

Claim 62

Claim 62 recites a device 1 for applying a substance to the hair. The device 1 has a receptacle 2 configured for containing the substance to be applied. The device 1 has an applicator portion 3 fixed on the receptacle 2 and that has at least one delivery orifice 50 enabling the substance to be delivered. The applicator portion 3 has teeth 41, 43 arranged around a closed curve, the gaps between the teeth being such that they allow hairs to pass between the teeth while enabling the substance to be retained within the curve. The closed curve has two longitudinal ends, the closed curve having a single tooth at each of the longitudinal ends. See for example, Fig. 6 or fig. 15.

(vi) Grounds of Rejection to be Reviewed on Appeal

If the amendment after final remains unentered, the rejection under 35 U.S.C. §112, second paragraph, concerning claims 1-42, 50 and 52-62, is appealed as being unnecessary. Reversal of the rejection is respectfully requested.

All rejections of claims based solely or in part on a combination of (1) De Laforcade (U.S. Patent No. 6,000,405) in view of (2) Margharehi (U.S. Patent

No. 5,937,866) under 35 U.S.C. §103(a) are to be reviewed on Appeal. As such, the rejection of claims 1-15, 18, 19, 31, 32, 35-43, 51, 52 and 60-62 based solely upon the proffered combination of De Lafocade in view of Margharehi is to be reviewed. Also, the rejections of claims 13, 14, 20-30, 33, 34, 43, 44, 46, 47, 50, 53, 55, 56 and 59 based in part on the proffered combination of De Lafocade in view of Margharehi are to be reviewed. In sum, the rejections of claims 1-15, 18-44, 46, 47, 50-53, 55, 56 and 59-62 under U.S.C. §103(a) in view of various combinations of references that include De Lafocade in view of Margharehi are appealed. Reversals of the rejections are respectfully requested.

Separately, the rejection of claims 43 and 52, under U.S.C. §103(a) in view of either De Lafocade in view of Margharehi, or De Lafocade in view of Margharehi in view of Kajgana (U.S. Patent No. 6,062,230) is to be reviewed on Appeal. Reversal of the rejection is respectfully requested.

Separately, the rejection of claims 13, 14, 20-30, 44 and 53 under 35 U.S.C. §103(a) in view of De Lafocade in view of Margharehi in view of Kajgana is to be reviewed on Appeal. Reversal of the rejection is respectfully requested.

Separately, the rejection of claims 46, 47, 50, 55, 56 and 59 under 35 U.S.C. §103(a) in view of a proffered combination of De Lafocade in view of Margharehi in view of Morganroth (U.S. Patent No. 4,273,144) is to be reviewed on Appeal. Reversal of the rejection is respectfully requested.

(vii) Argument

Rejection under 35 U.S.C. §112

As should be appreciated, the amendment after final addressed a rejection that was first and only presented within the final Office action. The claim language of “the gaps” was always present in the claims, including being present prior to the first Office action. The first Office action did not contain a rejection of the claim

language of “the gaps.” Thus, technically, the finality of the final Office action is not even proper.

Regardless, the thought that should be overriding is that the prosecution of the application should be advanced. As such, it is respectfully requested that the amendment after final should be entered because the amendment reduces issues for appeal. However, if the Examiner is of the mind set that the amendment after final does not reduce issues for appeal, then it is respectfully submitted that the claim language of “the gaps” must not be an issue. Such a determination is even reasonable in view of the lack of previous concern by the Examiner and the possible conclusion that the language does not cause any confusion. If the language is not an issue, then it is respectfully requested that the rejection under 35 U.S.C. §112 be withdrawn or overturned.

Rejections under 35 U.S.C. §103(a) that include De Lafocade in view of Margharehi

The rejections under 35 U.S.C. §103(a) that include De Lafocade in view of Margharehi have four large deficiencies that give rise to four issues identified below. To aid in the review, subheadings are provided within this section.

Issue 1

Whether the proffered rejection has any proper motivation to a person of ordinary skill in the art to make the asserted combination of teachings from (1) De Lafocade (U.S. Patent No. 6,000,405) and (2) Margharehi (U.S. Patent No. 5,937,866).

Issue 2

Whether possible proffered motivations to combine teachings from De Laforcade and Margharehi of (1) "distribution of dye throughout the hair" and (2) "[distribution of dye] along the hair shafts" (Final Office action, page 3, lines 10 and 11) would have led the person of ordinary skill in the art to even bother to modify the device of the Margharehi.

Issue 3

Whether negative teachings present within the references of the asserted combination (De Laforcade and Margharehi), which would have led the person of ordinary skill in the art away from the asserted combination, may properly be ignored.

Issue 4

Whether the possible proffered motivations of (1) "distribution of dye throughout the hair" and (2) "[distribution of dye] along the hair shafts" would have led the person of ordinary skill in the art to make the present invention or would have led the person of ordinary skill in the art to merely modify the De Laforcade such that dye would be output at each of the shafts of the perpendicular brush members.

Summary of the patent to De Laforcade (U.S. Patent No. 6,000,405)

The device of the De Laforcade patent is for dispensing hair tinting product (see the De Laforcade patent, col. 1, line 13). The advantage of the De Laforcade device is that it is designed so that a knot or other obstacle in the hair does not cause damage to an actuation mechanism or inadvertent actuation of the actuation mechanism (see the De Laforcade patent, col. 2, lines 3-12), such as a valve 41 on a reservoir (e.g., an aerosol spray can). In order to accomplish this benefit, the De Laforcade device has brush members 27 of an actuator positioned perpendicular to

a longitudinal axis of a supply reservoir 2 (see the De Laforcade patent, col. 4, lines 28-30). The brush members 27 are on a movable portion 22 that is constrained to tilt about a hinge axis of a hinge 23. As discussed in detail at Col. 5, lines 46-60, of the De Laforcade patent, the actuator is **used like a conventional hair brush** (see the De Laforcade patent, col. 5, line 46) so that support members 28 and 29 provide the constraint function to the movable portion 22. Thus, damage to an actuation mechanism and inadvertent actuation are avoided. However, with an actuating surface 21 located on the movable portion 22 for pivotable movement, the actuation is effectively controllable **when held like a conventional brush**. Within the example of Fig. 2 of the De Laforcade patent, the enlarged arrowhead shows the actuation movement.

The Office action has cited the De Laforcade patent for the structure of the brush members being in an oval.

Summary of the patent to Margharehi (U.S. Patent No. 5,937,866)

The device of the Margharehi patent is a **tip-up applicator** that has interchangeable components 29, 45 and 67) for dispensing hair dye. Two of the components (45 and 67) have teeth 57/77 extending along an axis of a container 15 (see the embodiments of Figs. 3, 4A and 4B of the Margharehi patent). Hair dye is permitted to seep out along the teeth 57/77 via lateral movement of a disk 59/79 (see the Margharehi patent, col. 4, lines 53 and 54). Specifically, the seepage along each of the teeth is controlled by bores 75 and 87 (one set for each tooth) that align upon the lateral movement of a disk 59/79 (see the Margharehi patent, col. 4, lines 52 and 53). Lateral movement of the disk 59/79 is controllable via a lateral shifted tab 63/83 (see the Margharehi patent, col. 4, lines 41-43). In general, it is to be appreciated that **during use the Margharehi device is inverted** (i.e., with the container up and the teeth pointing down) to allow the dye to seep out.

The Office action has cited the Margharehi patent for the structure of the teeth extending along the axis of the container.

Address of Issue 1

It is respectfully submitted that the proffered rejection, as set forth in the final Office action, does not have any proper motivation to a person of ordinary skill in the art to make the asserted combination of teachings from (1) De Lafocade (U.S. Patent No. 6,000,405) and (2) Magharehi (U.S. Patent No. 5,937,866).

At page 3, lines 9-11, the Office action recites:

Therefore, given the teaching of Magharehi, it would have been obvious to one having ordinary skill on the art at the time the invention was made to modify the device of the De Lafocade, as taught by Magharehi for distribution of dye throughout the hair and along the hair shafts.

It is believed that the Office action intends that the above passage to be a statement of motivation. However, when taken in the context of the De Lafocade and Magharehi patents, the passage is somewhat meaningless or at least circular/self-serving.

First, it must be queried whether the De Lafocade device is for distribution of dye throughout the hair and along the hair shafts. Second, it must be queried whether the Magharehi device is for distribution of dye throughout the hair and along the hair shafts.

It is respectfully submitted that the answer to both of the above two queries is affirmative. To be clear, both devices (De Lafocade and Magharehi) already distribute dye throughout the hair and along the hair shafts. However, because of these clear answers, the above passage from the Office action is, logically, meaningless. The person of ordinary skill in the art is left to wonder which patent is providing a reason modify. Moreover, the person of ordinary skill in the art is left to wonder why a modification to accomplish a function should be done if the function is already being performed.

With only a meaning passage as an asserted motivation, the Office action can only be deemed to lack a proper motivation to the person of ordinary skill in the art.

Thus, it is prudent to come to a conclusion that the Office action does not contain a proper motivation to a person of ordinary skill in the art to make the asserted combination of teachings from De Lafocade and Margharehi. It would be reasonable to conclude at this point and consider the rejection improper. However, in order to show additional failings of the rejection, the additional issues are addressed.

Address of Issue 2

It is respectfully submitted that the possible proffered motivations to combine teachings from De Lafocade and Margharehi for “distribution of dye throughout the hair and along the hair shafts” (Final Office action, page 3, lines 10 and 11) would not have led the person of ordinary skill to do anything to the De Lafocade device.

Assuming, arguendo, that the possible proffered motivation (see the Office action, page 3, lines 9-11) is given some level of credence, it must be queried what such motivation would have led a person of ordinary skill in the art to do to the De Lafocade device. Logically, the person of ordinary skill in the art would not do anything to the De Lafocade device if the reason is to distribute dye throughout the hair and along the hair shafts. The rationale is that the De Lafocade device already distributes dye throughout the hair and along the hair shafts.

Another way of viewing this is that the function is the same for the two devices (De Lafocade and Margharehi). Thus, there is no drive to the person of ordinary skill in the art to change a device to accomplish a function that is already being accomplished.

Thus, the possible proffered motivations to combine teachings from De Lafocade and Margharehi would not have led the person of ordinary skill to do anything to the De Lafocade device.

Address of Issue 3

It is respectfully submitted that negative teachings present within the De Lafocade and Margharehi patents would have led a person of ordinary skill in the

art away from making the asserted combination. Moreover, it is respectfully submitted that such negative teachings may not be properly be ignored.

The De Laforcade device has brush members 27 positioned perpendicular to a longitudinal axis of a supply reservoir 2 so that the device can be used like a conventional hair brush. Moreover, the brush members 27 are on a movable portion 22 that is constrained to tilt about a hinge axis of a hinge 23. These two features provide the advantage preventing damage to the actuation mechanism or inadvertent actuation of the actuation mechanism. It is reasonable that the person of ordinary skill in the art would not want to modify the De Laforcade device to have axially aligned teeth as set forth by the Margharehi patent.

First, operation of the De Laforcade device would then become awkward. Specifically, the De Laforcade device relies upon a generally downward (as viewed in Fig. 3A of the De Laforcade patent) pressing force on the actuation surface 21. If the De Laforcade device were modified to have axially-extending teeth, the actuation action would be along the same axis but in the opposite direction. It is queried why a person of ordinary skill in the art would want to modify a device to make it more awkward.

Second, the user would have to place a finger on the same side of the device from which hair dye is emitted. At best this would again be awkward and at worst quite messy. It is queried why a person of ordinary skill in the art would want to modify a device to make it awkward and messy.

Third, it should be appreciated that such a modification to the Laforcade device would likely destroy the beneficial functions presented within the De Laforcade patent. In other words, axial forces transmitted along axially-aligned teeth would be problematic. It should be recalled that damage to the actuation mechanism or inadvertent actuation are to be avoided, but axial forces would logically tend to increase, rather than decrease, such possibilities. It is queried why a person of ordinary skill in the art would want to modify a device and destroy the benefits of the device.

The Advisory action, page 2, continuation of item 11, addresses some of these points by stating that the features of the references need not be physically combinable. This appears to be an inappropriate application of the case law that is

cited within the Advisory action. If the Examiner is of the opinion that the structural features (i.e., axial teeth from Margharehi onto the De Lafocade device) are not going to be combined, then we appear to have reached a dispositive point in the Appeal. In other words, the rejection needs to be overturned. In view of the Examiner's statement, this would be reasonable.

Also, it must be stressed that loss of beneficial functions is not even considered within the final Office action or the Advisory action.

For this issue, the point that must be appreciated is that the final Office action and/or the Advisory action really do not address the negative teachings or at least do not properly address the negative teachings. In other words, the Office action and/or the Advisory action really don't answer the queries of why a person of ordinary skill in the art would want to modify a device to make it awkward and messy and/or destroy its benefits. It is respectfully submitted that it is not proper to ignore the negative teachings. Moreover, it is respectfully submitted that it is not proper to attempt to dismiss the negative teachings by merely asserting that miss-applied case law allows negative teachings to be ignored.

Apparently, the Examiner is of the opinion that, so long as various pieces and parts of a subject invention are found in various prior art references, the person of ordinary skill in the will automatically assemble the pieces into the subject invention. Also apparently, the Examiner is of the opinion that other teachings within the prior art references, which are not needed to assemble the subject invention or that actually teach away from assembling the various pieces and parts, would automatically be ignored by the person of ordinary skill in the art. Such would only be the case if the subject patent application is used as a guide to assemble the various needed pieces, while leaving out unneeded or undesirable aspects. Such approaches are not proper approaches to a determination of obviousness.

Thus, the negative teaching present within the De Lafocade and Margharehi patents may not be properly be ignored, and once these negative teaching are properly included in an obviousness consideration, the negative teachings would have led a person of ordinary skill in the art away from making the asserted combination.

Address of Issue 4

Although it is not completely clear from the final Office action and the Advisory action, it seems that the Examiner is of the opinion that the Margharehi patent provides some additional motivation to modify the De Laforcade device because the Margharehi patent teaches applying dye to the hair and along the shafts (emphasis added). However, assuming that the Margharehi patent does provide some additional motivation (see issues 1 and 2 above), it is respectfully submitted that the possible proffered motivations of (1) "distribution of dye throughout the hair" and (2) "[distribution of dye] along the hair shafts" would not have led the person of ordinary skill in the art to make the present invention. Instead, the possible proffered motivations would have led the person of ordinary skill in the art to merely modify the De Laforcade such that dye would be output at each of the shafts of the perpendicular brush members.

First, it is noted that the Advisory action, at page 2, continuation of item 11, lines 7 and 8, seems to be trying to make some distinction that the Margharehi device applies hair dye along the hair shafts and the De Laforcade device only applies hair dye to the hair. This statement seems quite odd. By the very nature of hair, each hair is a shaft. Thus, applying dye to a hair inherently results in applying dye to the hair shaft. This again leads to the same problems addressed for issues 1 and 2 (i.e., there is no proper motivation to combine the teaching of De Laforcade and Margharehi).

Despite the fact that the final Office action and the Advisory action are not clear and certainly do not articulate such a possibility, for the sake of completeness it should be considered if the Examiner intends the structure of the Margharehi patent that emits dye at each of the comb elements is the reason for the asserted combination. However, even if the person of ordinary skill in the art wanted to modify the De Laforcade such that dye would be output at each of the comb elements, then the person would logically just modify the structure to deliver dye to the **perpendicular** brush members. Such a result is logical and certainly does not run afoul of any of the negative teachings addressed above for issue 3.

Accordingly, if the person of ordinary skill in the art was of the mind set to

modify the De Laforcade device such that dye would be output at each of the shafts, the present invention would still not be provided. A combination device, which is different from the present invention, would be provided.

Summary regarding rejections that include De Laforcade in view of Margharehi

As discussed above, the rejections under 35 U.S.C. §103(a) that include De Laforcade in view of Margharehi have four large deficiencies. All of the rejections that include De Laforcade in view of Margharehi should be overturned in view of all of the deficiencies. However, even a finding that any one of these deficiencies is problematic leads to the same result.

Separately, the rejection of claims 43 and 52

The rejection of claims 43 and 52, under U.S.C. §103(a) in view of either De Laforcade in view of Margharehi, or De Laforcade in view of Margharehi in view of Kajgana (U.S. Patent No. 6,062,230) should be overturned for failure to provide all of the claimed limitations.

First, it should be noted that there is a lack of clarity within the final Office action. Claim 43 is rejected both in view of (1) De Laforcade in view of Margharehi (see page 2 of the final Office action) and (2) De Laforcade in view of Margharehi in view of Kajgana (see page 4 of the final Office action). Claim 52, which depends from independent claim 43, is only rejected in view of De Laforcade in view of Margharehi.

In view of the fact that the second mentioned rejection, which includes Kajgana, does not seem to address the limitations of claim 43, attention is primarily directed to the first mentioned rejection. However, it is to be appreciated that the arguments are equally applicable to the second rejection.

The final Office action appears to address the claimed structure at page 3, lines 12-15, by identifying the shutter (tab 83) of the Margharehi device. However, the tab 83 is not an applicator portion that is removable, and that is configured for fixing on a receptacle in a first position and in a second position different from the

first (see claim 43). The tab 83 is only a movable valve-like member on the applicator portion of the Margharehi device.

Accordingly, the Margharehi device does not provide all of the asserted limitations and the rejection should be overturned because the claimed invention would not result.

Separately, the rejection of claims 13, 14, 20-30, 43, 44 and 53

The rejection of claims 13, 14, 20-30, 43, 44 and 53 under 35 U.S.C. §103(a) in view of De Lafocade in view of Margharehi in view of Kajgana should be overturned for failure to provide a proper motivation to a person of ordinary skill in the art to even consider a further modification in view of Kajgana.

The final Office action, at page 4, lines 17 and 18, appears to present the proffered motivation for the combination that includes the teachings of Kajgana. Specifically, the proffered motivation is *“to provide a device that enables an even, controlled dye application onto the hair of the user.”*

First, it is to be appreciated that the Kajgana patent was cited for an asserted teaching of an internal sealing lip for engaging a skirt of a receptacle.

Turning to the structures of the De Lafocade and Margharehi devices, there does not seem to be any viable use, need, etc. for a sealing lip. With regard to the De Lafocade device, a flow channel 24 appears to snugly envelope a valve stem 3. With regard to the Margharehi device, the interchangeable components 45/67 are threaded into the container 15. Accordingly, there is no need for sealing lip. It is possible that the Examiner is again finding various, discrete parts within various prior art references, and thus believes that merely finding the parts is sufficient.

Next, it should be considered that the statement of *enabling an even, controlled dye application onto the hair of the user* has nothing to do with a modification concerning a sealing lip. Still further, the statement of *enabling an even, controlled dye application onto the hair of the user*, is merely a generic assertion of a benefit. Raw assertions of a benefit that is unconnected to a proffered modification certainly would not logically provide a proper motivation to a person of ordinary skill in the art.

Accordingly, in view of the lack of a proper motivation to the person of ordinary skill in the art, the person of ordinary skill in the art would not have made the proffered combination. As such, the rejection should be overturned.

Separately, the rejection of claims 46, 47, 50, 55, 56 and 59

The rejection of claims 46, 47, 50, 55, 56 and 59 under 35 U.S.C. §103(a) in view of De Lafocade in view of Margharehi in view of Morganroth should be overturned for failure to provide a proper motivation to a person of ordinary skill in the art to even consider a further modification in view of Morganroth and should also be overturned for failure to provide all of the claimed limitations.

The final Office action, at page 5, lines 18 and 19, appears to present the proffered motivation for the combination that includes the teachings of Morganroth. Specifically, the proffered motivation is “*to improve the applicator liquid spreading ability.*” This statement is taken directly from the Morganroth patent, which states in the abstract “Attachments may be used on the parting tool to improve its liquid spreading ability.” However, this beneficial function is directed to a device that has a long, slender and tapering projection 28 that is used to part the hair so that dye flowing through a hollow interior of the projection is deposited at the part location. One example of the attachment is an adapter 40, which is shown in Fig. 3 of the Morganroth patent. Another example of the attachment is the attachment 41c.

In distinction, both the De Lafocade and Margharehi devices are multi-tooth devices that do not deliver dye via a projection. Thus it is somewhat puzzling why a person of ordinary skill in the art would seek to improve the applicator liquid spreading ability with an adapter for a long, slender and tapering projection. It is respectfully submitted that the person of ordinary skill in the art would not be so motivated and thus the proffered motivation is not proper.

Moreover, it should be appreciated that if one of the applicator liquid spreading ability adapters for a long, slender and tapering projection is used within any sort of combination that may result from the De Lafocade and Margharehi patents, the present claimed invention would not result.

It is noted that the Morganroth patent does have another type of adapter 50, which is shown in Fig. 10. This adapter is not presented within the Morganroth

patent as being an applicator liquid spreading ability adapter. As such, it seems logical that the proffer motivation presented within the final Office action is not directed to the adapter 50. In distinction the adapter 50 is provided so that the elongated projection 28 is tilted.

The Office action does not present the adapter 50 for possible consideration. However, for the sake of completeness it should be noted that the proffered motivation (to improve the applicator liquid spreading ability) would not have led the person of ordinary skill in the art to use the tilting adapter within any sort of combination that may result from the De Lafocade and Margharehi patents. Also, the use of the tilting adapter 50 within any sort of combination that may result from the De Lafocade and Margharehi patents would still not provide the present claimed invention.

For example, independent claim 46 recites that the receptacle comprises a container and an adapter portion to enable the applicator portion to be fixed on the receptacle, the applicator portion being removable mounted on the adapter portion, said adapter portion having a sealing skirt defining a housing with at least one substance delivery duct opening out into the bottom thereof. None of the adapters of the Morganroth patent provide these structures.

Independent claim 47 recites that the receptacle comprises a container and an adapter portion to enable the applicator portion to be fixed on the receptacle, the applicator portion being removably mounted on the adapter portion, said adapter portion comprising a part made separately from the container and fixed thereon, and wherein the adapter portion has a covering skirt configured for extending around a neck of the container, and a receiver skirt for receiving the applicator portion. None of the adapters of the Morganroth patent provide these structures.

Independent claim 50 recites that the receptacle comprises a container and an adapter portion to enable the applicator portion to be fixed on the receptacle, the applicator portion being removably mounted on the adapter portion, wherein the applicator portion has an assembly skirt and wherein the adapter portion is configured to enable the user to deform the assembly skirt by pressing in opposite directions on bearing surfaces so as to modify the engagement between the

receptacle and the applicator portion, for the purpose of removing it. None of the adapters of the Morganroth patent provide these structures.

Accordingly, in view of the lack of a proper motivation to the person of ordinary skill in the art, the person of ordinary skill in the art would not have made the proffered combination. As such, the rejection should be overturned. Also, the Morganroth patent does not provide all of the asserted limitations and the rejection should be overturned because the claimed invention would not result.

Conclusion

Accordingly, the Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the rejection of claims 1-15, 18-44, 46, 47, 49-57 and 59-62 and return the case to the examiner for issuance of a Notice of Allowability.

(viii) Claims Appendix

A copy of the appealed claims is in the Appendix (attached).

(ix) Evidence Appendix

No additional is evidence submitted herewith.

(x) Related Proceedings Appendix

In view of the belief that the Appellant, the Appellant's legal representative, and the Assignee are not aware of any appeals or interferences that will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal, it is believed that there are no relevant decisions rendered and thus no copies of decisions are submitted herewith.

If there are any additional fees resulting from this communication, please charge all uncovered fees to our Deposit Account No. 16-0820, our Order No. 35485.

Respectfully submitted,
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August 2, 2005

(viii) Claims Appendix, Listing of Claims Involved in Appeal

Claim 1 A device for applying a substance to the hair, the device comprising: a receptacle having a longitudinal axis and configured for containing the substance to be applied, and an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has teeth arranged around a closed oval curve, each tooth having a longitudinal axis, the gaps between the teeth being such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve, and wherein the longitudinal axis of the teeth are substantially parallel to the longitudinal axis of the receptacle.

Claim 2 A device according to claim 1, wherein the applicator portion has two outer rows and at least one intermediate row situated between said outer rows, said outer rows meeting each other around said at least one intermediate row.

Claim 3 A device according to claim 1, wherein the applicator portion has teeth of different heights.

Claim 4 A device according to claim 1, wherein the applicator portion is removable, being configured for fixing on the receptacle in a first position and in a second position different from the first, the receptacle and the applicator portion being configured such that in the first position said at least one delivery orifice does not communicate with the substance contained in the receptacle, and in the second position said at least one delivery orifice communicates with the substance contained in the receptacle.

Claim 5 A device according to claim 1, wherein the applicator portion is configured to be fixed on the receptacle in two different positions only, with changeover from one position to the other being performed by removing the applicator portion, turning it through 180° about an axis of the receptacle, and then putting it back into place.

Claim 6 A device according to claim 1, wherein the applicator portion has two outer rows of teeth and an intermediate row situated between the two outer rows, with all of the teeth in the intermediate row being shorter than those of the outer rows.

Claim 7 A device according to claim 1, wherein the applicator portion has outer and intermediate rows of teeth, said rows superposing one another when the applicator portion is viewed in a direction recommended for moving the applicator portion through the hair.

Claim 8 A device according to claim 1, wherein the teeth are of oblong cross-section.

Claim 9 A device according to claim 1, having two outer rows of teeth and at least one intermediate row of teeth, the intermediate row having teeth whose free ends are set back from the free ends of the teeth in the outer rows by a distance lying in the range 4 mm to 8 mm, when the applicator portion is observed in a direction perpendicular to the axes of the teeth.

Claim 10 A device according to claim 1, wherein the applicator portion has a plurality of substance delivery orifices.

Claim 11 A device according to claim 10, wherein said orifices are of circular section.

Claim 12 A device according to claim 1, wherein the orifices open out between the rows of teeth.

Claim 13 A device according to claim 1, wherein the applicator portion has an internal sealing lip configured for bearing against a skirt of the receptacle when the applicator portion is fixed thereon, said internal lip defining an inside space that is

permanently in communication with the outside via said at least one substance delivery orifice.

Claim 14 A device according to claim 13, wherein said internal lip is of oblong cross-section.

Claim 15 A device according to claim 1, wherein the receptacle has at least one substance delivery duct in communication with said at least one delivery orifice.

Claim 18 A device according to claim 1, wherein the applicator portion is configured for fixing on the receptacle by snap-fastening.

Claim 19 A device according to claim 1, wherein the receptacle comprises a container and an adapter portion to enable the applicator portion to be fixed on the receptacle.

Claim 20 A device according to claim 19, wherein the adapter portion comprises a part made separately from the container and fixed thereon.

Claim 21 A device according to claim 19, wherein the adapter portion has a sealing skirt defining a housing with at least one substance delivery duct opening out into the bottom thereof.

Claim 22 A device according to claim 21, wherein said housing has a central region and side regions, the central region being deeper than the side regions, and wherein the applicator portion has a single duct opening out into the bottom of said central region.

Claim 23 A device according to claim 20, wherein the adapter portion has a covering skirt configured for extending around a neck of the container, and a receiver skirt for receiving the applicator portion.

Claim 24 A device according to claim 23, wherein the receiver skirt of the applicator portion has at least one catch in relief for engaging the applicator portion.

Claim 25 A device according to claim 19, wherein the adapter portion has two main faces and comprises a recess formed in each of said faces, and wherein the applicator portion has an index, said index being suitable for engaging in one or other of the said recesses to inform the user about the position of the applicator portion relative to the receptacle.

Claim 26 A device according to claim 19, wherein the adapter portion has at least one indication molded therein for enabling the user to identify the position of the applicator portion relative to the receptacle.

Claim 27 A device according to claim 19, wherein the applicator portion has an assembly skirt and wherein the adapter portion is configured to enable the user to deform the assembly skirt by pressing in opposite directions on bearing surfaces so as to modify the engagement between the receptacle and the applicator portion, for the purpose of removing it.

Claim 28 A device according to claim 27, wherein the assembly skirt has large faces with catches in relief suitable for engaging corresponding catches in relief formed on the adapter portion, and wherein the adapter portion has flats set back from the assembly skirt enabling the user to exert pressure on the bearing surfaces of the assembly skirt so as to enable the user to deform the spacing between the large faces of the assembly skirt to disengage the catches in relief of the assembly skirt from the adapter portion.

Claim 29 A device according to claim 27, wherein the assembly skirt of the applicator portion has ribs on its short sides to constitute the bearing surfaces for the user.

Claim 30 A device according to claim 1, wherein the receptacle is made integrally with the adapter portion.

Claim 31 A device according to claim 1, wherein the receptacle has a plurality of substance delivery ducts and the applicator portion has a plurality of shutters suitable for engaging in said ducts to shut them when the applicator portion is in a first position, and suitable for taking up positions outside said ducts when said applicator portion is in a second position.

Claim 32 A device according to claim 31, wherein said ducts are disposed asymmetrically about a midplane of the receptacle.

Claim 33 A device according to claim 1, wherein the receptacle comprises a removable cap at an end opposite from the applicator portion.

Claim 34 A device according to claim 33, wherein said cap is configured to allow the receptacle to stand on a plane surface with the applicator portion on top.

Claim 35 A device according to claim 1, wherein the receptacle does not have a cap at its end opposite from the applicator portion.

Claim 36 A device according to claim 1, wherein the receptacle comprises a compressible wall.

Claim 37 A device according to claim 1, wherein the receptacle is made of polyethylene.

Claim 38 A device according to claim 1, wherein the applicator portion is made of polypropylene.

Claim 39 A device according to claim 1, wherein the applicator portion has at least one index enabling its position relative to the receptacle to be identified.

Claim 40 A device according to claim 1, wherein the applicator portion has two outer rows of teeth, these rows comprising rectilinear portions which meet each other via series of teeth whose bottom regions extending from their base portions overlap when the applicator portion is observed along a direction parallel to said rectilinear portions.

Claim 41 A device according to claim 1, wherein said substance is a hair dye.

Claim 42 A device according to claim 1, wherein said substance is retained within said curve by capillarity.

Claim 43 A device for applying a substance to the hair, the device comprising:

a receptacle configured for containing the substance to be applied, and an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has teeth arranged around a closed curve, wherein the applicator portion is removable, being configured for fixing on the receptacle in a first position and in a second position different from the first, the receptacle and the applicator portion being configured such that in the first position said at least one delivery orifice does not communicate with the substance contained in the receptacle, and in the second position said at least one delivery orifice communicates with the substance contained in the receptacle.

Claim 44 A device for applying a substance to the hair, the device comprising:

a receptacle configured for containing the substance to be applied, and an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has teeth arranged around a closed curve, wherein said receptacle has a skirt and the applicator portion has an internal sealing lip configured for bearing against said skirt of the receptacle when the applicator portion is fixed thereon, said internal lip

defining an inside space that is permanently in communication with the outside via said at least one substance delivery orifice and that is capable of being isolated from an inside of the receptacle.

Claim 46 A device for applying a substance to the hair, the device comprising:

 a receptacle configured for containing the substance to be applied, and
 an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has teeth arranged around a closed curve, wherein the receptacle comprises a container and an adapter portion to enable the applicator portion to be fixed on the receptacle, the applicator portion being removable mounted on the adapter portion, said adapter portion having a sealing skirt defining a housing with at least one substance delivery duct opening out into the bottom thereof.

Claim 47 A device for applying a substance to the hair, the device comprising:

 a receptacle configured for containing the substance to be applied, and
 an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has teeth arranged around a closed curve, wherein the receptacle comprises a container and an adapter portion to enable the applicator portion to be fixed on the receptacle, the applicator portion being removably mounted on the adapter portion, said adapter portion comprising a part made separately from the container and fixed thereon, and wherein the adapter portion has a covering skirt configured for extending around a neck of the container, and a receiver skirt for receiving the applicator portion.

Claim 50 A device for applying a substance to the hair, the device comprising:

 a receptacle configured for containing the substance to be applied, and
 an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has

teeth arranged around a closed curve, wherein the receptacle comprises a container and an adapter portion to enable the applicator portion to be fixed on the receptacle, the applicator portion being removably mounted on the adapter portion, wherein the applicator portion has an assembly skirt and wherein the adapter portion is configured to enable the user to deform the assembly skirt by pressing in opposite directions on bearing surfaces so as to modify the engagement between the receptacle and the applicator portion, for the purpose of removing it.

Claim 51 A device for applying a substance to the hair, the device comprising:

a receptacle configured for containing the substance to be applied, and an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has teeth arranged around a closed curve, wherein the receptacle has a plurality of substance delivery ducts and the applicator portion has a plurality of shutters suitable for engaging in said ducts to shut them when the applicator portion is in a first position, and suitable for taking up positions outside said ducts when said applicator portion is in a second position.

Claim 52 A device according to claim 43, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 53 A device according to claim 44, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 54 A device according to claim 45, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 55 A device according to claim 46, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 56 A device according to claim 47, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 57 A device according to claim 48, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 58 A device according to claim 49, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 59 A device according to claim 50 wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 60 A device according to claim 51, wherein the gaps between the teeth are chosen such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve.

Claim 61 A device for applying a substance to the hair, the device comprising:

- a receptacle configured for containing the substance to be applied, and
- an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered,

wherein the applicator portion has teeth arranged around a closed curve, the gaps between the teeth being such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve and wherein the

applicator portion has two outer rows and at least one intermediate row situated between said outer rows, said outer rows meeting each other around said at least one intermediate row.

Claim 62 A device for applying a substance to the hair, the device comprising:

a receptacle configured for containing the substance to be applied, and an applicator portion fixed on said receptacle and having at least one delivery orifice enabling the substance to be delivered, wherein the applicator portion has teeth arranged around a closed curve, the gaps between the teeth being such that they allow hairs to pass between the teeth while enabling the substance to be retained within said curve, and wherein said closed curve has two longitudinal ends, the closed curve having a single tooth at each of said longitudinal ends.